

REMARKS/ARGUMENTS

The present amendment is submitted in an earnest effort to advance the case to issue without delay.

Claim 1 has been amended to specify that the cation counter to malonate in the salt is a quaternized form of either ammonia, dimethylethanolamine, tris(hydroxymethyl)amino methane and combinations thereof. Support is found in original claims 4 and 5. Also see page 3 (lines 18-23) and the comparative experiments at pages 26-27.

Claims 1-6 were rejected under 35 U.S.C. § 103(a) as unpatentable over Jokura et al. (US Patent 5,641,495). Applicants traverse this rejection.

Applicants have identified particularly effective organic acid salts for inhibiting discoloration of cosmetic compositions containing sunscreen agents. These are amine salts of malonic acid. A set of experiments are reported in the present application under Example 10. Table XII demonstrates the amine salts (ammonia, DMAE and Tris Amino) of malonic acid are much better at preventing discoloration than similar amine salts of glycolic acid.

Jokura et al. does not appreciate the special effectiveness of malonic acid salts. More particularly, the reference does not appreciate the selection of amine salts of malonic acid as the preferred agents to control discoloration. Note that the operative examples of the reference are not malonates and that the salt coounter ions are not amine types.

The Examiner has focused on column 3 (lines 41-45) of the reference. Therein are described various types of cationic counter ions for the dicarboxylic acid salt. One of these is triethanolamine. Alkanolamines are not within the amended claims. Triethanolamine is a tertiary amine while those presently claimed are either primary or secondary amines. The term "ammonium" salts appears in the cited passage. Similar to the terms "alkali metal", "alkali earth metal", "alkanolamine" and "basic amino acid", applicants view the term "ammonium" also as being generic rather than referring to quaternized ammonia, i.e. ammonium cation. The generic term "ammonium salts" includes a vast array of ammonium salts, e.g. such materials as triethylammonium, diethylammonium, and monoethylammonium cations. It is evident that Jokura et al. does not disclose the claimed amine salts of malonic acid. A prima facie case of obviousness has therefore not been presented.

Even arguing that Jokura et al. establishes prima facie obviousness, applicants have demonstrated that the claimed amine salts of malonic acid have discoloration preventing properties over those of the identical glycolic acid salts.

The Examiner has viewed Example 3 of Jokura et al. as the most relevant one. Sodium fumarate is illustrated in this Example. Applicants note that unlike fumaric acid which has an unsaturated double bond, malonic is not unsaturated. Example 3 utilizes a sodium salt whereas the claims focus on certain amine salts. Distinctions between malonic and fumaric acids and the claimed salts are broader than their similarities. Those skilled in the art would not have replaced sodium fumarate with an amine salt of malonic acid.

Claims 1-4 and 6 were rejected under 35 U.S.C. § 103(a) as unpatentable over Takada (JP 61/215318). Applicants traverse this rejection.

Takada does not disclose the claimed amine cationic counter ions of the present invention. The only cations mentioned in the reference are those of sodium and potassium. Consequently, the Examiner has not presented a prima facie case of obviousness with respect to this reference.

None of the Examples exemplify any malonate. The only mention of malonic acid is in a listing of 13 different types of acids. There is no particular identification of malonic acid as being especially useful. Based on the foregoing considerations, those skilled in the art would not have singled out malonic acid, especially an amine salt of malonic acid.

Claims 1-3 and 5-6 were provisionally rejected for obviousness-type double patenting over claims 1-7 of co-pending application no. 10/347,982 in view of Takada (JP 61/215318).

Applicants herewith provide a Terminal Disclaimer which is believed to overcome this rejection.

Claims 1-6 were provisionally rejected for obviousness-type double patenting over claims 1-5 of co-pending application no. 10/601,731 in view of Takada (JP 61/215318).

Applicants herewith provide a Terminal Disclaimer which is believed to overcome this rejection.

Claims 1-3 and 5-6 were provisionally rejected for obviousness-type double patenting over claims 1-2 and 7 of co-pending application no. 10/601,819 in view of Takada (JP 61/215318).

Applicants herewith provide a Terminal Disclaimer which is believed to overcome this rejection.

Claims 1-6 were provisionally rejected for obviousness-type double patenting over claims 1-5 of co-pending application no. 10/374,300 in view of Takada (JP 61/215318).

Applicants herewith provide a Terminal Disclaimer which is believed to overcome this rejection.

Claims 1 and 4 were provisionally rejected for obviousness-type double patenting over claims 1-5 of co-pending application no. 10/767,679 in view of Takada (JP 61/215318).

Applicants herewith provide a Terminal Disclaimer to overcome this rejection.

Claims 1, 4 and 6 were rejected for obviousness-type double patenting over claims 1-3 and 6-7 of US Patent 4,961,961 in view of Takada (JP 61/215318).

Applicants traverse this rejection.

Takada has been fully distinguished above. The Japanese reference does not disclose any amine salts of malonic acid. US Patent '961 is similarly deficient. Indeed, the US Patent is absolutely silent with respect to any mention of malonic acid or any of its salts. The Examiner has failed to present a prima facie case of obviousness with this combination of references.

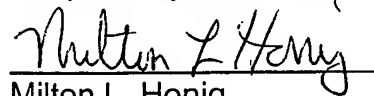
Claims 1, 4 and 6 were rejected for obviousness-type double patenting over claims 1-2 and 7 of US Patent 6,495,123 in view of Takada (JP 61/215318). Applicants traverse this rejection.

Takada has been fully distinguished above. The Japanese reference does not disclose any amine salts of malonic acid. US Patent '123 is similarly deficient. Indeed, the US Patent is absolutely silent with respect to any mention of malonic acid or any of its salts. The Examiner has failed to present a prima facie case of obviousness with this combination of references.

With respect to the information disclosure statement filed October 20, 2003, the Examiner noted that the wrong English language Abstract was provided for reference EP 1 262 166. Herewith attached is the US equivalent application (US Patent Application 2004/0146482). Accompanying this amendment is a PTO 1449 Form listing EP 1 262 166 and the English language equivalent. The Examiner is requested to consider this reference and provide applicants with an initialed PTO 1449 Form. In the event a fee is due, the Examiner should charge our Deposit Acct. No. 12-1155.

In view of the foregoing amendment, Terminal Disclaimer and comments, applicants believe the claims are now in condition for allowance and such action is herewith requested.

Respectfully submitted,



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